

REMARKS

This paper is presented in response to the Office Action. By this paper, claims 1, 2, 6, 7, 11, 12, 15-20 are amended. Accordingly, claims 1-28 remain pending.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments to the claims and the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner, and/or the merits of additional or alternative arguments.

II. Rejection of Claims 1, 6, 8, 9, 11, 13, 19, and 21 under 35 U.S.C. § 102

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP § 2131*.

The Examiner has rejected claims 1, 6, 8, 9, 11, 13, 19 and 21 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,795,458 to Murata ("*Murata*"). Applicant respectfully disagrees with the contentions of the Examiner, and submits that for at least the reasons set forth below, the rejection of

claims 1, 6, 8, 9, 11, 13, 19 and 21 should be withdrawn. Of the rejected claims, claims 1, 6, 11 and 19 are independent claims.

a. claim 1

In rejecting independent claim 1, the Examiner alleges that *Murata* discloses "...a laser driver having a first potentiometer (Fig 1: 12c, 13a first potentiometer measuring electromotive force)." *Emphasis added.* It would appear from the foregoing that the Examiner has characterized one or both of elements 12c and 13a of *Murata* as corresponding to the "first potentiometer" recited in claim 1. Notwithstanding this assertion, it does not appear that the characterization advanced by the Examiner is consistent with *Murata*. For example, elements 12c and 13a are disclosed by *Murata* as being "a first D/A conversion circuit portion," and "a bias current control circuit," respectively. Col. 6, lines 65-66; col. 7, line 39. The cited passage makes no reference to a "potentiometer," as recited in claim 1.

Not only has the Examiner failed to establish that *Murata* discloses the claimed "potentiometer" in combination with the other limitations of claim 1, but Applicant notes further that claim 1 has been amended herein to recite that the computer system is "configured to ... determine a first updated resistance value for the first potentiometer ..." *Emphasis added.*

In contrast, the Examiner has not established that *Murata* or any other reference teaches or suggests the aforementioned limitations in combination with the other limitations of claim 1.

b. claim 6

In rejecting independent claim 6, the Examiner alleges that among other things, *Murata* discloses a processor that "select[s] a first setting for a first potentiometer for controlling a bias current of a laser diode (Fig. 1: 16a bias current circuit to laser diode #2) (Col 4: 30-55)." *Emphasis added.* Notwithstanding this assertion, it does not appear that the characterization advanced by the Examiner is consistent with *Murata*. For example, Applicant can find no mention of a "setting" being "selected" for a "potentiometer" in the cited section or elements of *Murata*.

Not only has the Examiner failed to establish that *Murata* discloses the claimed "processor" in combination with the other limitations of claim 6, but Applicant notes further that claim 6 has been amended herein to recite that the processor executes instructions to "select a first resistance setting for a first potentiometer..." *Emphasis added.*

In contrast, the Examiner has not established that *Murata* or any other reference teaches or suggests the aforementioned limitations in combination with the other limitations of claim 6.

c. claim 11

In rejecting independent claim 11, the Examiner refers only to the elements of claim 1 and then alleges that "Since claim 11 recites the same or identical elements/limitations [as claim 1] it is inherent to

use patents ‘458 to recite [sic] the method of compensating temperature variation of a laser diode, product by process.” It would appear from the foregoing that the Examiner believes that claim 11 is a product by process claim that has the same or identical elements and limitations as claim 1. Notwithstanding this assertion, Applicant respectfully submits that the Examiner has mischaracterized claim 11.

“ A product by process claim ... is a product claim that defines the claimed product in terms of the process by which it is made. ... A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used ... so long as it is clear that the claim is directed to the product and not the process.” MPEP § 2173.05(p)(I). *Emphasis added.* As the foregoing makes clear, to qualify as a product by process claim, the claim must be directed to the product and not the process. Because claim 11 is directed to a process (“A method for compensating ...”), Applicant submits that claim 11 cannot be categorized as a product by process claim, notwithstanding the assertion of the Examiner, and the acts recited therein must be examined on their own merits.

Among other things, claim 11 requires “selecting a first setting” and “calculating a second setting” for a “first potentiometer.” However, as noted above, the portions of *Murata* relied upon by the Examiner in the rejection make no reference to a “potentiometer” such as is recited in the claims.

Not only has the Examiner failed to establish that *Murata* discloses the selecting and calculation of settings for a “potentiometer” in combination with the other limitations of claim 11, but Applicant notes further that claim 11 has been amended herein to recite “selecting a first resistance setting” and “calculating a second resistance setting,” respectively, for the first potentiometer. *Emphasis added.*

In contrast, the Examiner has not established that *Murata* or any other reference teaches or suggests the aforementioned limitations in combination with the other limitations of claim 11.

d. claim 19

In rejecting independent claim 19, the Examiner alleges that among other things, *Murata* discloses a computer readable program code means for causing a computer to “select a first setting for a *first potentiometer* for controlling a bias current of a laser diode...” *Emphasis added.* In support of the rejection of claim 19 the Examiner references Figures 1 and 5 and “Col 7-8: 30-67.” Notwithstanding this assertion, it does not appear that the characterization advanced by the Examiner is consistent with *Murata*. For example, Applicant can find no mention of the claim 19 limitation “selecting[ing] a first setting for a potentiometer for controlling a bias current of a laser diode” in the cited section or figures of *Murata*.

Not only has the Examiner failed to establish that *Murata* discloses the selecting and calculation of settings for a “potentiometer” in combination with the other limitations of claim 19, but Applicant notes further that claim 19 has been amended herein to recite that the computer readable program code

means cause the computer to “select a first resistance setting for a first potentiometer...” *Emphasis added*. In contrast, the Examiner has not established that *Murata* or any other reference teaches or suggests the aforementioned limitation in combination with the other limitations of claim 19.

e. claims 8, 9, 13 and 21

In rejecting dependent claims 8, 9, 13 and 21, the Examiner alleges that “it is inherent for the control system executes the temperature compensation program instructions to set the temperature of the laser diode to a selected value, and the temperature compensation program instructions is stored in memory ... or setting the temperature of the laser diode to a selected value or desired value.”

By virtue of their dependency from one of claims 1, 6, 11 or 19, dependent claims 8, 9, 13 and 21 include all the limitations of the corresponding base claim. As discussed at II.a-d. above however, the Examiner has not established that *Murata* anticipates claims 1, 6, 11 or 19. Accordingly, the Examiner has likewise failed to establish that *Murata* anticipates corresponding dependent claims 8, 9, 13 and 21.

As to the purported inherency alleged by the Examiner, Applicant respectfully notes that inherency is not readily established. For example, as noted in MPEP § 2112, the Examiner must provide rationale or evidence showing inherency. In particular, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original). Moreover, the Court of Appeals for the Federal Circuit has noted that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described by the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

Finally, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In light of the foregoing discussion, Applicant submits that the Examiner has failed to establish the inherency of the subject matter of claims 8, 9, 13 and 21.

f. conclusion

In light of the foregoing, Applicant respectfully submits that the Examiner has not established that *Murata* anticipates claims 1, 6, 8, 9, 11, 13, 19, and 21, at least because the Examiner has not established that each and every element as set forth in each of claims 1, 6, 8, 9, 11, 13, 19 and 21 is found in

Murata, because the Examiner has not established that the identical invention is shown in *Murata* in as complete detail as is contained in claims 1, 6, 8, 9, 11, 13, 19 and 21, and because the Examiner has not shown that *Murata* discloses the elements of claim 1, 6, 8, 9, 11, 13, 19 and 21 arranged as required by those claims.

Applicant thus respectfully submits that the rejection of claims 1, 6, 8, 9, 11, 13, 19 and 21 should be withdrawn.

III. Rejection of Claim 18 under 35 U.S.C. § 103

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over *Murata*. Applicant respectfully disagrees however and submits that for at least the reasons set forth below, the rejection of claim 18 should be withdrawn.

By virtue of its dependence from independent claim 11, dependent claim 18 requires “selecting a first resistance setting for a first potentiometer...” and “calculating a second resistance setting for the first potentiometer ...” As discussed at II.c, above however, the Examiner has not established that these limitations, in combination with the other limitations of claim 11, are taught or suggested by *Murata*. Nor has the Examiner established that this defect in *Murata* is remedied by any other reference(s). Thus, even if the *Murata* device is modified in the allegedly obvious fashion advanced by the Examiner, the resulting combination would fail to include all the limitations of claim 18.

In light of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 18, at least because the Examiner has not established that the method allegedly disclosed in *Murata*, when modified in the purportedly obvious fashion, teaches or suggests all the limitations of claim 18. Applicant thus respectfully submits that the rejection of claim 18 should be withdrawn.

IV. Allowable Subject Matter

Applicant acknowledges with thanks the indication of the Examiner that claims 22-28 are allowed, and Applicant also wishes to thank the Examiner for the careful review of those claims.

The Examiner has indicated that claims 2-5, 7, 10, 12, 14-17 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In view of the discussion set forth herein, Applicant respectfully declines to rewrite claims 2-5, 7, 10, 12, 14-17 and 20 in independent form at this time.

Applicant submits the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. In general, Applicant agrees with the Examiner that the inventions to which claims 2-5, 7, 10, 12, 14-17, 20 and 22-28 are respectively directed are patentable over the cited references, but respectfully disagrees with the Examiner's statement of reasons for allowance as set forth in the Office Action.

Particularly, Applicant submits that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, the patentability of a claim is properly determined with reference to the claim as a whole. Accordingly, Applicant does not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claim allowable and Applicant does not make any admission or concession concerning the Examiner's statements in the Office Action concerning the allowability of claims 2-5, 7, 10, 12, 14-17, 20 and 22-28 in view of the cited references.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-28 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 2nd day of November, 2006.

Respectfully submitted,

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